

REMARKS

Amendments:

Claims 47-59 have been withdrawn by the Examiner as being directed to an invention that is independent or distinct from the invention originally claimed. No amendments have been made, and no claims have been canceled or added.

Objections to the Drawings:

Figure 4 of the drawings has been objected to under 37 CFR 1.83(a). In making the objection, the Examiner contends that Figure 4 "fails to show how the integrated docking device 330 can actually accept both tape and HDD media without encountering any interference by element 122," and further that Figure 4 "fails to show, in structural detail, how the docking device 330 can actually accept and read both tape and HDD media." The Examiner also states, "elements 122 and 231 do not provide sufficient structure for one of ordinary skill in the art to ascertain the physical make up of the integrated docking device."

The Applicant traverses the objection to Figure 4 on the grounds that Figure 4 fully complies with all applicable requirements, including those set forth in accordance with CFR 1.83(a).

The Applicant notes that CFR 1.83(a), in its entirety, states:

The drawing in a nonprovisional application must show every feature of the invention specified in the claims. However, conventional features disclosed in the description and claims, where their detailed illustration is not essential for a proper understanding of the invention, should be illustrated in the drawing in the form of a graphical drawing symbol or a labeled representation (e.g., a labeled rectangular box).

In response to the Examiner's statement that, "elements 122 and 231 do not provide sufficient structure for one of ordinary skill in the art to ascertain the physical make up of the integrated docking device," the Applicant points out that element 122 is described as a "docking interface ... [that is] configured to communicatively link with the cartridge interface 121 in order to facilitate the passage of data between the disk cartridge 110 and any other device such as the host computer 140." (Applicant's specification, page 11, lines 6-15.)

1 Moreover, the docking interface 122 "...can be at least a portion of a
2 connector, such as a pin connector or the like, which is configured to matingly
3 connect with the cartridge interface 121 in the case wherein the cartridge interface is
4 also at least a portion of a connector ... for example, the cartridge interface 121 can
5 be a first portion of an SCSI connector while the docking interface 122 can be a
6 second portion of an SCSI connector" (Applicant's specification, page 11,
lines 16-23.)

7 Furthermore, "the cartridge interface 121 and the docking interface 122 need
8 not be connector portions which are configured to contact one another ... [but can
9 be, for example] at least a portion of a wireless transmission device ... [which
10 utilizes, for example] infra-red, laser, or short-range radio transmission ... wherein
11 contact therebetween is not required." (Applicant's specification, page 12,
lines 20-32.)

12 The Applicant further describes element 231 as "a tape read/write device
13 which is configured to perform read/write operations on the tape cartridges 240 ...
14 [wherein] tape read/write devices are known in the art and are typically included in
15 the tape drive 230." (Applicant's specification, page 14, line 33 through page 15, line
16 2.) The Applicant goes on to explain that, typically, "... the tape is extracted from the
17 cartridge so that the data can be read from, and/or written to, the tape ... [and when]
18 the reading, and/or writing, of the tape is completed, the tape is wound back into the
cartridge" (Applicant's specification, page 1, lines 20-25.)

19 Thus, the Applicant submits that element 122, being at least a portion of a
20 connector or at least a portion of a wireless transmission device, or the like, is a
21 conventional feature, of which a detailed illustration is not essential for a proper
22 understanding of the invention. The Applicant also submits that element 231, being
23 a tape read/write device, is also a conventional feature, of which a detailed
illustration is not essential for a proper understanding of the invention.

24 Therefore, in view of the foregoing, and in view of the fact that Figure 4 is
25 described as "a schematic diagram" (Applicant's disclosure, page 5, line 12), the
Applicant contends that Figure 4 fully complies with each and every requirement of
CRF 1.83(a) because elements 122 and 231 are conventional features that are
represented in accordance with the requirements set forth by CFR 1.83(a).

1 Accordingly, the Applicant respectfully requests that the objection to Figure 4 be
2 withdrawn and that the drawings be accepted.

3 In response to the Examiner's statements that Figure 4 "fails to show how the
4 integrated docking device 330 can actually accept both tape and HDD media without
5 encountering any interference by element 122," and that Figure 4 "fails to show, in
6 structural detail, how the docking device 330 can actually accept and read both tape
7 and HDD media," the Applicant contends that the Examiner is essentially requiring
8 the Applicant to "disprove a negative."

9 That is, there is no reasonable expectation, and no evidence, that any
10 interference by element 122 will be encountered, nor is there any reasonable
11 expectation, or evidence, that the docking device cannot accept and read both tape
12 and HDD media when the drawings are viewed in light of the description.

13 Moreover, the Applicant submits that simply positioning the docking interface
14 122 at a location that is different than the location of a tape portal through which the
15 tape is extracted from the tape cartridge 240 would preclude any possibility of
16 interference of the tape with the docking interface 122. The Applicant further
17 submits that this is one of many possibilities that would not be difficult to envision in
18 view of the teachings of the Applicant's disclosure, especially for one skilled in
19 the art.

20 Accordingly, the Applicant asserts that one of ordinary skill in the art, after
21 studying the Applicant's disclosure, could not only easily ascertain the physical make
22 up of the integrated docking device, but could also easily build the integrated
23 docking device so as to function and/or operate in the manner intended by
24 the Applicant.

25 Rejection of Claims Under 35 U.S.C. § 112:

Claim 45 has been rejected under 35 U.S.C. § 112, first paragraph, as failing
to comply with the enablement requirement. The Examiner contends that, "the claim
contains subject matter that was not described in the specification in such a way as
to enable one skilled in the art to which it pertains, or with which it is most nearly
connected, to make and/or use the invention ... [and that] the original specification
did not describe in detail how a single docking device 330 (Figure 4) can link either a
tape cartridge or a hard disk drive to the hose device ... [and that] the specifics of

1 how the tape read/write device 231 and the docking interface 122 are designed to
2 co-locate on a single docking device to serve the claimed functions is not known.”
3 (Office action, paragraph 4.)

4 The Applicant traverses the Examiner’s rejection of claim 45 on the grounds
5 that claim 45 fully complies with all the requirements of 35 U.S.C. § 112, first
6 paragraph, which is otherwise known as, “the enablement requirement.”

7 The Applicant notes that, “[t]he test of enablement is whether one reasonably
8 skilled in the art could make or use the invention from the disclosures in the patent
9 coupled with information known in the art without undue experimentation.” (MPEP
10 2164.01.)

11 The Applicant submits -- in view of the Applicant’s description of the docking
12 interface (122) as at least a portion of a connector and/or at least a portion of a
13 wireless transmission device, and in view of the fact that tape read/write devices as
14 well as connectors and wireless transmission devices are known in the art -- that one
15 reasonably skilled in the art could make or use the docking device (330) (as claimed
16 in claim 45) from the disclosures in the description and drawings coupled with
17 information known in the art without undue experimentation. Accordingly, the
18 Applicant also submits that the Applicant’s specification, and claim 45, both fully
19 comply with the enablement requirement as set forth by 35 U.S.C. § 112,
20 first paragraph.

21 The Applicant therefore respectfully requests that the rejection of claim 45
22 under 35 U.S.C. § 112, first paragraph, be withdrawn.

23 Rejection of Claims Under 35 U.S.C. § 103:

24 Claims 28, 37, 38, and 44 have been rejected under 35 U.S.C. § 103(a) as
25 being unpatentable over U.S. Patent 6,731,455 to Kulakowski et al. in view of U.S.
Patent 5,329,412 to Stefansky.

Also, claims 45 and 46 have been rejected under 35 U.S.C. § 103(a) as being
unpatentable over Kulakowski in view of Stefansky as applied to claim 28, and
further in view of U.S. Patent 5,666,342 to Kim.

The Applicant traverses the rejections of claims 28, 37, 38, and 44-46 under
35 U.S.C. § 103(a) on the grounds that a *prima facie* case of obviousness has not
been established in regard to those claims.

1 A *prima facie* case of obviousness requires that:

- 2 1) there must be some suggestion or motivation, either in the references
3 themselves or in the knowledge generally available to one of ordinary skill
4 in the art, to modify the reference or to combine the reference teachings;
- 5 2) there must be a reasonable expectation of success; and,
- 6 3) the prior art reference (or references when combined) must teach or
7 suggest all the claim limitations. (MPEP 2142.)

8 Firstly, the Examiner has not established that there is some suggestion or
9 motivation, either in the references or in the knowledge generally available to one or
10 ordinary skill in the art, to make the combination, as is required for a *prima facie* case
11 of obviousness.

12 Although the Examiner contends that, "it has been held that discovering an
13 optimum value of a result effective variable involves only routine skill in the art," the
14 Applicant counters with the assertion that combining the cited references is not
15 equivalent to discovering an optimum value of a result effective variable.

16 Furthermore, "legal precedent can provide the rational supporting
17 obviousness only if the facts in the case are sufficiently similar to those in the
18 application." (MPEP 2144.) The Applicant contends that the facts of *In re Boesch*,
19 which the Examiner cites and on which the Examiner relies, are not sufficiently
20 similar to those in the Applicant's application, and thus cannot be used in a rejection
21 of the Applicant's claims.

22 Also, in regard to claims 28, 37, 38, and 44, the Examiner contends that, "it
23 would have been obvious for one of ordinary skill in the art to have provided
24 Kulakowski with a housing having the same dimensions of a magnetic tape housing
25 because such HDD cover had been known in the art, as demonstrated
by Stefansky."

In response, the Applicant notes that, "[a] statement that modifications of the
prior art to meet the claimed invention would have been 'well within the ordinary skill
of the art' at the time the invention was made' because the references relied upon
teach that all aspects of the claimed invention were individually known in the art is
not sufficient to establish a *prima facie* case of obviousness without some objective
reason to combine the teachings of the references." (MPEP 2143.01; emphasis
added.) The Applicant asserts that the Examiner's statement does not amount to an

1 “objective reason to combine the teachings of the references”, as required for a
2 *prima facie* showing of obviousness.

3 Additionally, the Applicant notes that, “[i]f a proposed modification would
4 render the prior art invention being modified unsatisfactory for its intended purpose,
5 then there is no suggestion or motivation to make the proposed modification.” (Id.)
6 Furthermore, “[i]f the proposed modification or combination of the prior art would
7 change the principle of operation of the prior art invention being modified, then the
8 teachings of the references are not sufficient to render the claims *prima*
9 *facie* obvious.” (Id.)

10 Kulakowski teaches that the hard disk cartridge (2) is dual-ended, as is
11 depicted in figure 1A of Kulakowski. That is, Kulakowski teaches that the hard disk
12 cartridge (2) has dual sets of data interfaces (18), dual sets of power interfaces (26),
13 and dual sets of gripper indentations (32a, 32b, 32c, and 32d), wherein one set is on
14 one end of the cartridge and the other set is on an opposite end. The dual-ended
15 nature of the hard disk cartridge of Kulakowski is essential to the principle of
16 operation of the system disclosed by Kulakowski. (See, for example, Kulakowski,
17 col. 8, line 49 through col. 11, line 19.)

18 The dual-ended nature of the hard disk cartridge of Kulakowski is directly
19 contradictory to the cartridge of Stefansky. That is, Stefansky specifically teaches a
20 single-ended cartridge. Therefore, there is no motivation to combine Kulakowski and
21 Stefansky because the Examiner's proposed modification of the cartridge of
22 Kulakowski to be single-ended as taught by Stefansky would change the principle of
23 operation of the prior art invention, and/or the proposed modification would render
24 the prior art invention unsatisfactory for its intended purpose.

25 That is, configuring the cartridge of Kulakowski in the manner of the single-
ended cartridge taught by Stefansky would render the system of Kulakowski
unsatisfactory for its intended purpose and/or would change the principle of
operation of the system of Kulakowski. Thus, in accordance with MPEP 2143.01,
there is no suggestion or motivation to combine Kulakowski and Stefansky.

Secondly, the Examiner has not established that the prior art references,
when combined, teach or suggest all of the claim limitations, as is required for a
prima facie case of obviousness. As stated in the MPEP, “[a]ll words in a claim must

1 be considered in judging the patentability of that claim against the prior art.” (MPEP
2 2143.03.)

3 Claim 28 includes the following elements and/or limitations:

4 *a host device;*

5 *a first storage media having a tape cartridge form factor and including a hard
disk drive for storage of data;*

6 *a second storage media having the tape cartridge form factor and including a
7 length of tape for storage of data;*

8 *a picker configured to move the first storage media and the second storage
media; and*

9 *a docking device in communicative linkage with the host device and adapted
10 to receive the first storage media and the second storage media from the picker.*

11 The Applicant contends that neither Stefansky nor Kulakowski teach or
12 suggest all of the elements and/or limitations of claim 28. For example, neither of
13 those references teach or suggest “*a second storage media having the tape
14 cartridge form factor and including a length of tape for storage of data*” as is required
by claim 28.

15 Also, neither of those references teach or suggest “*a docking device in
16 communicative linkage with the host device and adapted to receive the first storage
17 media and the second storage media from the picker*” as is required by claim 28.

18 Additionally, the Examiner states that, “Stefansky discloses a portable hard
19 disk drive device [which] teaches that the hard disk drive device housing can have
20 the dimensions of a tape cartridge.” In fact, Stefansky actually discloses, at most, “a
21 single disk drive which ... conforms to the dimensions of a tape cassette having a
height of 0.6 inch.” (Stefansky, col. 1, lines 58-61.)

22 However, in claim 28, the Applicant does not claim “a hard disk drive
23 conforming to the dimensions of a tape cassette having a height of 0.6 inch.”
24 Rather, the Applicant claims, in part, “a storage media having a tape cartridge form
25 factor.” The Applicant defines “cartridge form factor” as “a set of standardized
physical configurational and dimensional criteria” (Applicants specification at
page 1, lines 29-30.) The Applicant asserts that “conforming to the dimensions of a
tape cassette having a height of 0.6 inch” is not equivalent to “having a tape

1 cartridge form factor.” Therefore, the cited prior art references do not teach or
2 suggest all of the elements and/or limitations of the Applicant's claim 28.

3 Moreover, the Examiner states that “the apparatus and docking device [of
4 Stefansky] is also capable of handling any tape cartridges.” (Office action, page 5.)
5 In response, the Applicant contends that it is impossible for either Stefansky or
6 Kulakowski to handle any tape cartridges because neither apparatus of Stefansky or
7 Kulakowski includes a tape drive or any means of reading from, and/or writing to, a
8 tape cartridge.

9 The Applicant therefore contends, for at least the reasons set forth above, that
10 a *prima facie* case of obviousness has not been established for claim 28.
11 Accordingly, the Applicant respectfully requests that the rejection of claim 28 be
12 withdrawn and that claim 28 be allowed.

13 In regard to claims 37, 38, and 44-46, the Applicant notes that “[i]f an
14 independent claim is nonobvious under 35 U.S.C. 103, then any claim depending
15 therefrom is nonobvious.” (MPEP 2143.03.) Therefore, claims 37, 38, and 44-46
16 are nonobvious for at least the reasons set forth above with respect to claim 28,
17 because claims 37, 38, and 44 depend from claim 28.

18 Accordingly, the Applicant respectfully requests that the rejections of claims
19 37, 38, and 44-46 be withdrawn.

20 In regard to the Examiner's citation of Kim in the obviousness rejection of
21 claims 45 and 46, the Applicant contends that Kim is irrelevant in view of the
22 arguments presented above against the obviousness rejection of claim 28. That is,
23 in view of the legal principle cited herein above that any claim which depends from a
24 nonobvious independent claim is also itself nonobvious, then it follows that a prior art
25 reference cited against a dependent claim, but not against the independent claim, is
not relevant in view of the arguments against the obviousness rejection of the
independent claim. Thus, claims 45 and 46 are nonobvious for the reasons set forth
above with respect to claim 28, and Kim has no relevance in regard to
those reasons.

Nevertheless, the Applicant contends that there is no motivation to combine
Kim with Stefansky and/or Kulakowski because to do so would render the prior art
unsatisfactory for its intended purpose and/or because to do so would change the
principle of operation of one or more of the references.

1 More specifically, to combine Kim with Stefansky and/or Kulakowski would
2 render one or more of those prior art references unsatisfactory for its intended
3 purpose and/or would change the principle of operation of one or more of those
4 references, because Kim teaches, at most, a CD (compact disk) player and a
5 cassette tape player and/or recorder, and does not teach or suggest a hard disk
6 cartridge as do both Stefansky and Kulakowski. That is, the apparatus of Kim is not
7 configured to accept a hard disk cartridge and the apparatus of Stefansky and
Kulakowski are not configured to accept a compact disk.

8 Furthermore, even if there was motivation to combined Kim with either
9 Stefansky and/or Kulakowski (which there is not), the resulting combination would
10 still not include all of the elements and/or limitations of claim 28 (or of claims 45 and
11 46 which depend from claim 28). That is, even if Stefansky and/or Kulakowski
and/or Kim were to be combined, the resultant combination still would not contain all
12 of the following elements and/or limitations which are required by claims 45 and 46:

13 *a host device;*

14 *a first storage media having a tape cartridge form factor and including a hard
disk drive for storage of data;*

15 *a second storage media having the tape cartridge form factor and including a
length of tape for storage of data;*

16 *a picker configured to move the first storage media and the second storage
17 media; and*

18 *a docking device in communicative linkage with the host device and adapted
19 to receive the first storage media and the second storage media from the picker.*

20 Thus, even if claim 28 was obvious in view of Stefansky and Kulakowski
21 (which it is not), claims 45 and 46 would still be nonobvious in view of Stefansky,
Kulakowski, and Kim for the reasons set forth above.

22 SUMMARY

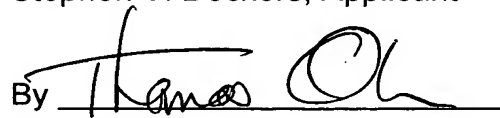
23 The Applicant believes this communication constitutes a full and complete
24 reply to the final Office action mailed on 11/23/2005. The Applicant further believes
25 that claims 28, 37, 38, and 44-46 are not anticipated by, and are not obvious in view
of, the cited prior art references. The Applicant therefore requests timely allowance
of claims 28, 37, 38, and 44-46.

1 The Examiner is respectfully requested to contact the below-signed attorney if
2 the Examiner believes this will facilitate prosecution toward allowance of the claims.

3
4 Respectfully submitted,
5 Stephen V. Deckers, Applicant

6 Date: January 21, 2005

7 By



8 Thomas Olson

9 Attorney for Applicant

10 Reg. No. 44,271

11 (509) 327-4748

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Application No. 10/656,040
Docket No. 10004377-3
Response After Final Action